

ELECTION

Applicant elects, with traverse, what the Examiner has characterized as “Invention I”, deemed drawn to a gas shield, and corresponding to claims 9-11.

REMARKS

The Examiner has identified two ‘inventions’ in the pending claims. The Examiner’s classification of the ‘inventions’ include Group I consisting of claims 9-11 drawn to a gas shield and classified by the Examiner in class 174, subclass 5, and Group II consisting of claims 21-37 drawn to an apparatus and classified by the Examiner in class 219, subclass 136.

With respect to the restriction of Groups I and II, the Examiner indicated that inventions I and II are related as combination and subcombination under MPEP §806.05(c), which states that “inventions are distinct if it can be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in **>another materially< different *>combination<”. While the Examiner asserted that, “[i]n the instant case, the combination as claimed does not require the particulars of the subcombination as claimed” (*See Office Action, August 18, 2006, p. 2*), the Examiner has failed to show that the combination as claimed does not require the particulars of the subcombination as claimed. That is, the Examiner merely concluded that the combination does not require the particulars of the subcombination, without showing which particulars may not be required in the combination. Therefore, the Examiner has not shown that the inventions are distinct. As such, the Examiner has not met the burden to show distinctness between the combination and subcombination. Accordingly, the restriction requirement must be withdrawn.

In addition, the Examiner must also show that reasons for restriction are necessary. *See MPEP §806.05(c)*. Reasons for insisting upon restriction may be shown by a separate classification thereof, a separate status in the art when they are classifiable together, and a different field of search. *MPEP §808.02*. The Examiner stated that a different field of search is required for the combination and subcombination. *See Office Action, supra at 2*. Applicant believes that a search of one group of claims would include a search of the other claim groups. That is, a search of claims 21-37 (Group II) includes a search of that called for in claims 9-11

(Group I). Therefore, Applicant believes that there is no serious burden on the Examiner if restriction is not required. *See MPEP §808.02.* ,

Therefore, in light of at least the foregoing, Applicant believes that claims 9-11 and 21-37 should be rejoined for examination and consideration in the present application. The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,

/Kevin R. Rosin/

Kevin R. Rosin
Registration No. 55,584
Phone 262-376-5170 ext. 15
krr@zpspatents.com

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P.O. ADDRESS:
Ziolkowski Patent Solutions Group, SC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170